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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/632,072
Filing Date: July 31, 2003
Appellant(s): MCGOWAN ET AL.

Hunter E. Webb
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/9/08 appealing from the Office action mailed

10/11/07.

    (1) Real Party in Interest

    A statement identifying by name the real party in interest is contained in the brief.

    (2) Related Appeals and Interferences

    The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

    (3) Status of Claims

    The statement of the status of claims contained in the brief is correct.

    (4) Status of Amendments After Final

    No amendment after final has been filed.

    (5) Summary of Claimed Subject Matter

    The summary of claimed subject matter contained in the brief is correct.

    (6) Grounds of Rejection to be Reviewed on Appeal

    The appellant's statement of the grounds of rejection to be reviewed on appeal is

correct.

    (7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,029,196	LENZ	2-2000
2003/0046375 A1	PARKMAN ET AL.	3-2003
5,950,010	HESSE ET AL.	9-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
> are such that the subject matter as a whole would have been obvious at the time the invention was made to a
> person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

Claims 1-5, 7-13, 15-17, 20-26, 28-31, and 33-39 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Lenz, U.S. Patent No. 6,029,196, in view of Official Notice.

As to claim 1, Lenz discloses a method for preserving hand-held mobile devices user

settings, comprising:

initiating an enterprise application on a device (Col. 2, ln. 66 – Col. 3, ln. 12), and

reading a client properties file from a device memory of the device into an application

memory (Fig. 10; Fig. 11, items 1114 and 1105; memory is an inherent component of clients

and servers operating in the networking environment of Lenz);

receiving an updated properties file from a server in the device memory (Fig. 10, item

1006; Col. 5, ln. 34-44);

comparing time values of the updated properties file to time values of the client

properties file in the application memory (Fig. 9; Col. 2, ln. 12-22; a file version of the client's

file and the file version of the server's file may be interpreted as time values, as the "new

files" relate to time in that an older file version precedes a newer file version in time) to

determine whether the client properties have been changed by a user (Col. 4, ln. 1-10 and

40-42; Col. 4, ln. 59 – Col. 5, ln. 16);

reconciling, based on the comparison, the client properties file and the updated

properties file to yield a reconciled properties file (Fig. 10; Col. 1, ln. 63 – Col. 2, ln. 22; Col.

4, ln. 1-10); and

writing the reconciled properties file to the device memory (Fig. 10-11; Col. 5, ln. 34-

44).

Lenz does not explicitly disclose that the device is a mobile device.

Official Notice is taken that mobile devices such as: laptops, mobile phones, PDAs, etc., were well known at the time of the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Lenz with a well-known mobile device to improve mobility and flexibility.

As to claim 8, the claim is rejected for the same reasons as claim 1 above. Additionally, Lenz discloses that the configurations and preferences are stored both on the central server and locally (Col. 5, ln. 13-16) and retaining changes made to the client properties file by a user (Col. 4, ln. 1-10 and 40-42; Col. 5, ln. 8-16).

As to claim 15, the claim is rejected for the same reasons as claim 1 above. Additionally, Lenz discloses that the client requests the configuration file (Fig. 10).

As to claims 22 and 35, the claims are rejected for the same reasons as 8 above.

As to claim 28, the claim is rejected for the same reasons as claim 1 above.

As to claim 2, Lenz discloses modifying the client properties file prior to receiving the updated properties file (Col. 4, ln. 1-10 and 40-42), wherein time values of the updated properties file are compared to time values of the modified client properties file (Fig. 9; Col. 1, ln. 63 – Col. 2, ln. 22), and wherein the modified client properties file is reconciled with the updated properties file to yield the reconciled properties file (Fig. 10; Col. 1, ln. 63 – Col. 2, ln. 22; Col. 4, ln. 1-10).

As to claims 9, 16, 23, 29, and 36, the claims are rejected for the same reasons as claim 2 above.

As to claims 3 and 13, the claims are rejected for the same reasons as claim 15 above.

As to claim 5, Lenz discloses the client properties file and the updated properties file each contain a configuration of the enterprise application (Abstract, ln. 14-17), and wherein the client properties file further contains the mobile device user settings (Fig. 10; Col. 4, ln. 1-10).

As to claims 18 and 31, the claims are rejected for the same reasons as claim 5 above.

As to claims 7, 20, and 33, the claims are rejected for the same reasons as claim 1

above.

As to claim 10, Lenz discloses the reading steps comprises:

determining if the client properties file is in the client database (Fig. 10);

reading the client properties file from the device memory in the client properties file

is not in the client database (Fig. 10);

copying the client properties file to the client database (Fig. 10); and

deleting the client properties file from the device memory after the copying the step

(Col. 5, ln. 10-16).

As to claims 24 and 37, the claims are rejected for the same reasons as claim 10 above.

As to claims 11, 25, and 38, the claims are rejected for the same reasons as claim 1

above.

As to claims 21 and 34, the claims are rejected for the same reasons as claim 1 above.

As to claim 4, Official Notice is taken that memory in a client is selected from the group consisting of a disk, a memory stick, and random access memory.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Lenz by using random access memory as this is well known in the art. Random access memory is used in clients to store information.

As to claims 12, 17, 26, 30, and 39, the claims are rejected for the same reasons as claim 4 above.

Claims 6, 19, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lenz, in view of Parkman et al. (Parkman), U.S. Publication No. 2003/0046375 A1.

As to claim 6, Lenz discloses the invention substantially as in parent claim 1, including the comparing step comprises comparing the updated properties file to the client properties file (Fig. 9; Col. 1, ln. 63 – Col. 2, ln. 22), but is silent on comparing dates.

However, Parkman discloses comparing dates (Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Lenz by comparing dates as taught by Parkman in order

to ensure the most recent version of a configuration is implemented in a networking

environment (Parkman: Abstract).

As to claims 19 and 32, the claims are rejected for the same reasons as claim 6 above.

Claims 14, 27, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Lenz, in view of Hesse et al. (Hesse), U.S. Patent No. 5,950,010.

As to claim 14, Lenz discloses the invention substantially as in parent claim 8, but is

silent on the client and server databases are DB2 databases.

However, Hesse discloses that DB2 is a conventional means of implementing

databases in a client/server environment (Col. 6, ln. 9-16).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Lenz by using DB2 databases as taught by Hesse as this

is a conventional and reliable means of implementing databases when desired for a

client/server environment (Hesse: Col. 6, ln. 9-16).

As to claims 27 and 40, the claims are rejected for the same reasons as claim 14 above.

(10) Response to Argument

- **Argument 1** (see page 7, lines 7-15, of the appeal brief)

Further, the Office's argument that the limitation "hand-held mobile device" not be given its full weight is in error. Elements of the claim are not to be ignored simply because they are in the preamble.

Still further, the Office's factual assertion is not properly based upon common knowledge. For example, Applicants assert there are many operations that a normal computer system may be able to perform operations that a hand-held mobile device may not, due to the limitations brought on by the size and portability of the hand-held mobile device. Thus, a hand-held mobile device that performs the functions of the claimed invention is not obvious to one skilled in the art as asserted by the Office.

- **Examiner's Response to Argument 1**

Appellant requests findings for a "hand-held mobile device", but Appellant is reminded that "hand-held" only appears in the pre-amble and is not given weight. The body of the claim merely references "a mobile device" which may include systems such as a laptop. Additionally, the first limitation of the claim refers to "a mobile device" as opposed to referring back to the hand-held mobile devier in the preamble, as would be properly done by claiming "**the** mobile device" as opposed to "**a** mobile device".

Clearly a laptop would be an obvious component of a networking environment as in

Lenz, as laptops have been an integral part of the computer industry for many years. A laptop

may perform the normal operations of a computer system and is not limited by size and

portability. Additionally, the definition of hand-held is ambiguous as a laptop may be held in

a user's hands. In fact, Examiner has used a laptop by holding it in one hand and typing with

the other hand, when on the move.

- **Argument 2** (see page 7, line 17 – page 8, line 4, of the appeal brief)

In the above referenced Final Office Action, the Examiner alleges that the cited

references teach or suggest comparing time values of the updated properties file to time

values of the client properties file in the application memory to determine whether the client

properties have been changed by a user. The Office cites a passage of Lenz that describes

comparing versions of particular software. However, the Office's equating of the comparison

of versions in Lenz with the time information is flawed. This is because a version of

particular software may be completely independent of the time in which it was created. For

example, a particular software may not have specific version designations, in which case the

comparison of Lenz would be worthless. Furthermore, an application that has a specific

version designation may undergo changes, e.g., hot fixes, within a particular version. On the

other hand, checking for time values may indicate that a file has changed even if its version,

if any, remains the same and is thus, independent of version.

- Examiner's Response to **Argument 2**

Appellant argues the equation of a comparison of versions with time information,

stating that "a version of a particular software may be completely independent of the time in

which it was created." Examiner respectfully disagrees. Clearly an updated version of

software will have been created at a time later than the previous version of the same

software.

Additionally, Appellant argues checking time values may indicate that a file has

changed even if its version, if any, remains the same. Even assuming this is the case, it is

noted that the features upon which applicant relies are not recited in the rejected claims.

Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993).

- **Argument 3** (see page 8, lines 5-15, of the appeal brief)

Furthermore, the comparison of Lenz is not done to determine whether client

properties have been changed by a user. Rather, Lenz is only concerned with whether the

latest version of the software has been pushed from the server to the client and not with

changes with client properties. In contrast, the claimed invention includes "...comparing

time values of the updated properties file with time values of the client properties file in the

application memory to determine whether the client properties have been changed by a

user." Claim 1. As such, the comparing of the claimed invention is not merely of versions

numbers to determine whether software needs to be replaced with an updated version as in

Lenz, but rather time values of the updated properties file are compared to time values of the

client properties file to determine whether the client properties have been changed by a user.

For the above reasons, the version number comparison of Lenz does not teach or suggest the

comparing of time values of the claimed invention.

- **Examiner's Response to Argument 3**

Lenz is concerned with determining if changes to a client properties file have been

made by a user, as related to the comparison of time/version information (as discussed in the

response to argument 2). Lenz discloses comparing the file version numbers of a server's

configuration and a client's configuration, file updates may be made based on this

comparison (Col. 4, ln. 59- Col. 64). Additionally, Lenz discloses that changes may be made

by a user to the client properties file (Col. 4, ln. 1-10 and 40-42) and that such changes may

be propagated by the very update mechanism discussed in the preceding sentence (Col. 4, ln.

59 – Col. 5, ln. 16).

- **Argument 4** (see page 8, line 16 – page 9, line 6, of the appeal brief)

        In the above referenced Final Office Action, the Examiner alleges that the cited

references teach or suggest reconciling the updated properties file with the client properties

file in the client database to yield a reconciled properties file to retain changes made to the

client properties file by a user. As stated above, the goal of Lenz is to make sure that the most

current version of the server software is pushed from the server to the client. To this extent,

Lenz does not take into consideration whether the client properties file has been changed by

a user. As such, Lenz does not attempt to retain such changes to the client properties file, but

rather, simply overwrites them with the newest version. The claimed invention, in contrast,

includes "…reconciling the updated properties file with the client properties file in the client

database to yield a reconciled properties file to retain changes made to the client properties

file by a user." Claim 8. As such, the reconciling in the claimed invention is done in such a

way that changes made to the client properties file by a user are retained and does not

merely blindly replace one version with another as does Lenz. Thus, the reconciling of the

claimed invention is not taught or suggested by the version replacement of Lenz.

- **Examiner's Response to Argument 4**

Appellant argues Lenz is not concerned with determining whether a user has changed

client properties and retaining changes made to a properties file by a user. Examiner

respectfully disagrees and points out that the user may set preferences, thereby overriding

default preferences set by an administrator (Lenz: Col. 4, ln. 1-10 and 40-42) and may

override an initial configuration of a system with a configuration that has been created by a

user, thereby allowing the user to move to different systems and retain user preferences

(Lenz: Col. 5, ln. 8-16).

- **Claims 6, 14, 19, 27, 32, and 40** (see page 9)

Applicant's argument that the dependent claims are allowable due to the allowable

nature of the independent claims is not persuasive, as the rejections of the independent

claims have been maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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